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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,753	03/10/2000	Ronald M. Evans	SALK1510-3	4924

30542 7590 12/14/2005

FOLEY & LARDNER LLP  
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SAN DIEGO, CA 92138-0278

EXAMINER
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DUNSTON, JENNIFER ANN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,753

Applicant(s)

EVANS ET AL.

Examiner

Jennifer Dunston

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5, 9, 10, 12-14, 16-25 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 3-5, 9-10, 12-14, 16-25 and 38 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The Examiner of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Jennifer Dunston, Art Unit 1636.

Claims 3-5, 9-10, 12-14, 16-25 and 38 are pending in the instant application.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3-5, 18-25 and 14 & 16 (as they read on the sequence of SEQ ID NO: 4), drawn to an isolated polynucleotide encoding a SMRT co-repressor polypeptide having at least 80% sequence identity to SEQ ID NO: 5 (human SMRT), classified in class 536, subclass 23.5.
- II. Claims 9-10, 17 and 14 & 16 (as they read on the sequence of SEQ ID NO: 6), drawn to an isolated polynucleotide encoding a SMRT co-repressor having at least 80% sequence identity to SEQ ID NO: 7 (mouse SMRT $\alpha$ ), classified in class 536, subclass 23.5.
- III. Claims 12-13, 38 and 14 & 16 (as they read on the sequence of SEQ ID NO: 8), drawn to an isolated polynucleotide encoding a SMRT co-repressor having at least 80% sequence identity to SEQ ID NO: 9 (mouse SMRT $\beta$ ), classified in class 536, subclass 23.5.

The inventions are distinct, each from the other because of the following reasons:

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The nucleic acids of Groups I-III are chemically, biologically, and functionally distinct from each other and thus one does not render the other obvious. Each nucleic acid molecule has a distinct function in that it encodes a polypeptide distinct from the polypeptides of the other groups. For example, mSMRT $\beta$  polypeptide lacks the majority of the sequence in hSMRT and mSMRT $\alpha$  polypeptides that is homologous to N-CoR repression domain 1 (RD1) (e.g. specification, paragraph beginning at line 6 of page 50). The different amino acid sequences of the proteins encoded by the claimed nucleic acid molecules will each have distinct biological functions. Furthermore, the product of each group is not needed to produce the products of the other groups (each of which can be isolated from cells or organisms, made synthetically, and/or are self-replicating without the need for the isolated products of the other groups). Therefore, the inventions of the groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for any other Group (i.e. the searches are not coextensive), restriction for examination purposes as indicated is proper. Each nucleic acid search requires a separate search of the commercial nucleic acid databases.

Note, this restriction to examination of a single SMRT (hSMRT, mSMRT $\alpha$ , or mSMRT $\beta$ ) is due to the now very high and undue burden for examining more than one sequence which is caused by the continual exponential increase of size of the sequence databases to be searched for each sequence, resulting in a corresponding increase in computer search time and examiner time for reviewing the computer search results. Therefore, the limited resources of the Office no longer permit examination of more than one distinct sequence in an application. Furthermore, the limitations of claims 3, 14, and 23-25 require additional sequence alignments to

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be performed subsequent to obtaining the commercial database search results. The requirement for additional sequence alignments increases the amount of computer time for the alignment and increases the examiner time for reviewing the alignment results.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR, <http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business

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Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jennifer Dunston  
Examiner  
Art Unit 1636

jad

**CELIAN QIAN**  
**PATENT EXAMINER**

